REMARKS

Response to 35 U.S.C. § 102(b) Rejection

Claims 1,4 and 6-12 have been initially rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,978,768 to McGovern et al.

These claims have been amended to distinguish the present invention from the cited reference. Applicant respectfully notes that the claim amendments act to clarify or further limit the claims but do not act to introduce new matter into the claims.

The Examiner has admitted that the McGovern patent does not teach a free standing cabinet for housing an advertising display in connection with a recruiting device. (Office Action, No. 7). Applicant has included this limitation in its newly-presented independent claim 1, thus making this claim 1 novel with respect to the cited reference. Claims 4 and 6-12 depend from claim 1, and incorporate all of its limitations. As such, it is believed that, as a result of the addition of this limitation, these claims are also patentably distinct.

Applicant has also included in claim 1 the additional limitations that the recruiting station is for use by "individual" recruits, and the recruiting station is "unmanned." Support for these limitations can be found in the specification at Paragraph [0027].

Applicant has also added dependant claim 15, which contains the limitation that the recruiting station is non-networked. The term "non-networked" means that the stand-alone unit is not linked to the Internet or another similar computer network. There is support for this limitation in the specification at Paragraph [0030]("The system of the present invention may be a stand alone unit or may be a series of networked units..."). This limitation is not taught in the McGovern patent, which deals solely with data transfer via a "computer network" such as, for

example, the Internet. (column 3, lines 55-58; column 6, lines 55-56). As such, it is believed that, as a result of the addition of this limitation, claim 15 is patentably distinct.

Applicant has also added dependant claim 16, which contains the limitation that the collected data is manually downloaded from the station. This is in contrast to, for example, downloading via the Internet. There is support for this limitation in the specification at Paragraph [0031]("[The collected data] can either be manually downloaded or electronically transferred to the agency's central database."). This limitation is not taught in the McGovern patent, which, as mentioned previously, deals specifically with data transfer via a "computer network" such as the Internet. (column 3, lines 55-58; column 6, line 56). As such, it is believed that, as a result of the addition of this limitation, claim 16 is also patentably distinct.

Applicant has also added independent claim 17, which contains the limitation that the collected data from the recruiting station is searched for placement purposes after the data has been retrieved or downloaded from the station. There is support for this limitation in the specification at Paragraph [0033]("The recruit simply enters his information on the keyboard, reviews the screen and saves it. The agency then collects the information and enters it into its permanent database. The recruit's information can then be searched....") and Paragraph [0031]("The data is collected by the agency on a periodic basis by downloading the collected data from the center."). This limitation is not taught in the McGovern patent, which teaches that comparison of information from a job seeker with information regarding available jobs occurs solely at a remote site computer, without the step of retrieval or downloading from the remote site computer. (column 16, lines 5-15). As such, it is believed that, as a result of the addition of this limitation, claim 17 is also patentably distinct.

Applicant has also included independent claim 18 and related dependant claims 19-21. There is support for the method of claim 18 in the specification at Paragraph [0035] ("It is, therefore, an object and feature of the subject invention to provide a method and apparatus for collecting useful data from potential recruits for use by a placement agency ..."). Claim 18 contains the limitation of a free standing cabinet for housing an advertising display in connection with a computerized recruiting device. The use of a free standing cabinet is not taught in the McGovern patent. (Office Action, No. 7). As such, it is believed that, as a result of the addition of this limitation, independent claim 18, as well as claims 19-21 dependant therefrom, are patentably distinct.

Response to 35 U.S.C. § 103(a) Rejections

Claims 3, 5, 13 and 14 have been initially rejected by the Examiner under 35 U.S.C. §103(a) as being anticipated by U.S. Patent No. 5,978,768 to McGovern et al. Claim 2 has been initially rejected by the Examiner under 35 U.S.C. §103(a) as being anticipated by U.S. Patent No. 5,978,768 to McGovern et al. in view of U.S. Patent No. 6,048,271 to Barcelou.

Applicant respectfully submits that the present invention is not obvious under 35 U.S.C. §103(a) with respect to the single reference or combination of references cited by the Examiner, and in support presents the arguments found herein.

With regard to the question of obviousness, Applicant respectfully reminds the Examiner that the Federal Circuit noted in *In re Fritch* that:

> Under Section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried

> out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. (emphasis original) 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992).

As to claim 2, neither McGovern nor Barcelou provide any motivation, suggestion or incentive to combine the references to accomplish Applicant's present invention.

The McGovern patent discloses a computer to be used by a person searching for employment (column 6, lines 42-43). The Examiner admits, however, that the McGovern patent does not teach or suggest a free-standing cabinet for use with the computer to house an advertising display (Office Action, No. 7).

Barcelou teaches a computerized device housed in a kiosk. (column 5, lines 25-28). The device, however, is not disclosed in an enabling fashion with regard to use for recruiting or employment. The device is not employment-related; instead, the device is a gaming device used to solicit, organize and administer an active sport or skill game between multiple players playing simultaneously. (column 3, lines 9-16). Examples include a computerized video game and a manually operated hockey game. (column 3, lines 22-25). These gaming devices are completely unrelated to the employment-related devices taught in the McGovern patent and function in a manner different than the present invention. In order to show a connection between the Barceleou and McGovern patents, the Examiner has noted that the device in Barceleou may be used for "recruitment services" (column 4, line 42) in connection with a non-enabling laundry list of over 100 vague and/or unrelated services (column 4, lines 25-63) (including but not

limited to "Church Services," "Human Services," "Coupon Services" and "Detective Services") that Barceleou teaches as being "additional optional services" (column 3 line 34) which may be included in its device. Barceleou notes that the list of services is to "limited only by the imagination." (column 3, lines 45-46). This type of statement does not rise to the level of teaching or disclosure of an operable invention, as none of these optional services are elaborated upon or explained in detail. Thus, these briefly-mentioned items provide neither an element missing from the present invention nor a motivation to combine the Barceleou patent with the McGovern patent to make obvious the present invention.

Applicant further argues that the Barceleou patent in fact teaches away from the present invention in a number of aspects. First, the Barceleou patent requires that the primary device "necessarily include equipment for accepting and dispensing currency..." (column 3, line 17-18). Thus, it appears that the device taught in the Barceleou patent is a commercial, pay-for-use item that reflects its simultaneous gaming functionality. In contrast, Applicant notes that the present invention is not a pay-per-use item. In Paragraph [0053] the specification indicates that a recruit will be attracted to the system by the advertising, and will then follow the directions on the CRT screen, which require first entering his name, and then proceeding to subsequent steps. None of these subsequent steps include a payment step.

A primary advantage of the present invention is that the device is unmanned (Paragraph [0027]). As such, a prospective job-seeker can feel at ease and unpressured when using the device. Paragraph [0027] in the specification further indicates that the device of the present invention allows a user to avoid any "unwanted sales pitch" from the device or its provider. The Barceleou patent, on the other hand, specifically requires the use of currency, which indicates

that access to the device is being sold to the user. As such, the Barceleou patent teaches away from both the McGovern patent and an advantageous aspect of the present invention.

Second, Barcelou teaches that an important aspect of the device is the provision of a game of skill to "two or more" players. (column 6, lines 7-10). Thus, the device promotes competitive participation between the user and others in interactive games such as "hockey, chess, video football and others..." (column 6, lines 25-35). In contrast, an advantage of the present invention is that the device "is not manned" (Paragraph [0027]). This is reflected in the language in revised claim 1, which indicates that key data is collected from a "individual" recruit. Thus, the user can utilize the device alone, without interaction from others, in a more "friendly, secure" environment. (Paragraph [0027]). This individualized use of the device teaches away from the multi-party competitive device shown in Barcelou as well as an advantageous aspect of the present invention.

Summary

In summary, the presently presented claims have been amended to distinguish the present invention from the cited patents. Independent claims 1 and 18 teach a free standing cabinet for housing an advertising display in connection with a computerized recruiting device, which is novel and not taught by the cited patents. Further, the present invention is not obvious in light of the cited patents, as there is no suggestion or motivation to combine the patents to produce the presently claimed invention. In fact, the Barceleou patent teaches away from certain advantageous aspects of the present invention. As the cited patents do not anticipate or make obvious the current invention as expressed in revised claims 1-21 presented herein, it is believed that these claims are patentably distinct and should be allowed.

* * * * *

In commenting upon the references and in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the references and the present invention have been mentioned, even though such differences do not appear in all of the claims. It is not intended by mentioning any such unclaimed distinctions to create any implied limitations in the claims. Not all of the distinctions between the prior art and Applicant's present invention have been made by Applicant. For the foregoing reasons, Applicant reserves the right to submit additional evidence showing the distinctions between Applicant's invention to be unobvious in view of the prior art.

The foregoing remarks are intended to assist the Examiner in re-examining the application and in the course of explanation may employ shortened or more specific or variant descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be considered to be exhaustive of the facets of the invention, which render it patentable, being only examples of certain advantageous features and differences that Applicant's attorney chooses to mention at this time.

Reconsideration of the application and allowance of all of the claims are respectfully requested. In view of the foregoing Response, Applicant respectfully submits that all of the claims are allowable, and Applicant respectfully requests the issuance of a Notice of Allowance.

Respectfully submitted,

Constance G. Rhebergen
Reg. No. 41,267
Attorney for Applicant

Date: Oct 7, 2004

BRACEWELL & PATTERSON, L.L.P.
P.O. Box 61389
Houston, Texas 77208-1389
(713) 223-2900